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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/879,913

06/14/2001

Mitsuru Maeda

35.C15455

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7590

08/03/2006

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

HENEGHAN, MATTHEW E

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/879,913	MAEDA, MITSURU	
	<b>Examiner</b>	<b>Art Unit</b>	
	Matthew Heneghan	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,9-11,14,15,20,21,24,26,28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24 and 28 is/are allowed.
- 6) ☒ Claim(s) 1,2,9-11,14,15,20,21,26 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

1. In response to the previous office action, claims 1, 9, 14, 20, 24, 26, 28, and 30 have been amended and claims 3-6, 8, 12, 16-18, 22, 25, 27, 29, and 31 have been cancelled. Claims 1, 2, 9-11, 14, 15, 20, 21, 24, 26, 28, and 30 have been examined.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1, 2, and 9-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 as amended no longer produces a result that is tangible; claims must have a result that is useful, concrete, and tangible.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 14, 15, 20, 21, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO Patent Publication No. 99/48296 to Shamoon et al.

Regarding claims 14, 15, 20, and 30, Shamoon discloses a streaming media system that includes a control block containing data from a Control Stream that is watermarked (i.e. combined into raw data) into audio and visual streams (see p. 7, lines 23-26). The Control is an IPMP (Intellectual Property Management and Protection) component (see p. 4, line 27 and p.5, lines 6-9 and p.21, lines 23-27) of an MPEG-4 stream (see column 4, lines 21-22) that includes rules governing use of intellectual property (see p.12, line 11 to p. 19, line 5). Means for forming control information based upon multiple pieces in intellectual property-related information is disclosed (see column 12, lines 12-20 and figure 7). Shamoon also discloses the encrypting of the IPMP stream (see p. 25, lines 1-2), which would necessarily require decryption of the stream at the receiving end.

Shamoon does not disclose the use of a data field in the intellectual property information that is related to lists of patents.

However these differences are only found in the nonfunctional data stored on the apparatus or are not functionally involved in the steps recited. Data identifying a particular set of patents is not functionally related to the substrate of the apparatus and the forming steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms

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of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any data in the fields of the article of manufacture or to perform forming steps that have any type of intellectual property-related content, such as patent lists, as shown in Shamoon because such data and steps do not functionally relate to the substrate of the article of manufacture or the steps involved and merely labeling the data differently from that in the prior art would have been obvious. See *Gulack* cited above.

As per claim 21, received video is displayed (see Shamoon, p. 6, 19-24).

#### ***Allowable Subject Matter***

4. Claims 24 and 28 are allowed.
5. Claims 1, 2, and 9-11 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 set forth in this Office action.
6. The following is a statement of reasons for the indication of allowable subject matter: Claims 1, 24, and 28 each recite the generation of an encryption key based upon patent list data. No art could be found that anticipates this limitation or would

render this limitation obvious over the art heretofore cited. Claims 9-11 would be allowance based upon their dependence on claim 1.

### ***Response to Arguments***

7. Applicant's arguments, see Remarks, filed 23 May 2006, with respect to the rejections under 35 U.S.C. 103 of claim 1 et al. have been fully considered and are persuasive. The rejections under 35 U.S.C. 103 of claim 1 et al. have been withdrawn; however, Applicant has removed the recitation of a tangible output (formerly in step (c)) from claim 1, leading to a rejection under 35 U.S.C. 101.

8. Regarding the rejections of claim 14 et al., Applicant's arguments filed 2 December 2005 have been fully considered but they are not persuasive. Shamoon discloses the use of encrypted IPMP and this may be applied to any intellectual property information. Since the particular data as recited has been determined to be nonfunctional descriptive material, it does not need to be taught by the prior art. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques, can be reached at (571) 272-6962.

**Any response to this action should be mailed to:**  
Commissioner of Patents and Trademarks

Art Unit: 2134

P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**  
(571) 273-3800

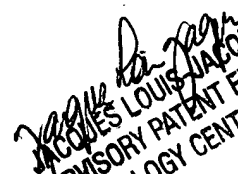
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MEH



July 27, 2006

  
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